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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/023,110	12/17/2001	Dale R. Heron	GB 000193	2423

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BRIARCLIFF MANOR, NY 10510

EXAMINER

HOYE, MICHAEL W

ART UNIT	PAPER NUMBER
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2623

MAIL DATE	DELIVERY MODE
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05/31/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/023,110

Applicant(s)

HERON ET AL.

Examiner

Michael W. Hoyer

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 May 2007.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-9, 11-16, 23 and 24 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-9, 11-16, 23 and 24 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- 1) ☒ Certified copies of the priority documents have been received.
 - 2) ☐ Certified copies of the priority documents have been received in Application No. _____.
 - 3) ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicants' submission filed on May 21, 2007 has been entered.

Response to Arguments

2. Applicants' arguments filed on May 21, 2007 have been fully considered but they are not persuasive.

Regarding amended independent claim 1 and amended independent claim 12, the Applicants argue on page 13 of the Remarks section that:

There is simply no teaching or suggestion in Matthews III, Portuesi, and Sie, alone or in combination, [of] allowing access to the material based on the scheduled broadcast time, as recited in independent claims 1 and 12. Rather, Portuesi merely teaches to display and activate a URL during certain periods and Sie merely teaches that the controller 612 of the set top box 600 enables playback upon a request from an authorized user. That is, any unlocking in Sie is not based on the scheduled broadcast time of the program.

In response, the Examiner respectfully disagrees with the Applicants because the Portuesi reference was not used to reject the specific claim limitation as described above, and more specifically, regarding the Sie reference, Sie specifically teaches in col. 3, lines 50-61 that, "the

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subscriber management system 124 [or the claimed “broadcaster”] contains account information for all users such as customer names, addresses, set top box addresses, credit history, subscription status, and video on demand (VOD) status. This information is used to enable programs on the set top box(es) 120 of each user. Interactive screens for selecting services are formulated by the subscriber management system 124. The screens allow the user to select additional products or services...” The subscriber management system 124 interacts with the program request database 136 in order to provide program entitlement to users (see col. 4, lines 21-23; 35-38; 41-46; 53-55 and 64-67). Furthermore, control information is sent and received by both the subscriber management system 124 and the set top boxes 120, where in one example, once a program that requires special authorization is requested, the subscriber management system 124 is queried for entitlement (see col. 5, lines 33-38 and 54-63; col. 6, line 63-col. 7, line 8; col. 7, lines 39-43 and 64-65; col. 8, lines 2-13; col. 13, lines 33-35; and col. 22, lines 46-59). In col. 4, lines 41-46, as cited above, Sie specifically teaches that some embodiments can limit the amount of times a user can replay a program during a defined period or number of uses in a period, and this usage information is stored in the program request database 135 and used by the subscriber management system 124 before entitling a set top box 120... Therefore, it would have been obvious to one of ordinary skill in the art to have used the teachings of Sie to have limited the time a user can access the multimedia material, or additional products or services, based on the scheduled broadcast time by unlocking or enabling the multimedia material, for the advantage of only allowing access to multimedia material during the scheduled broadcast time in situations where the multimedia material is time dependent on the scheduled broadcast time, such as advertising information or time sensitive news information, for example. Therefore, the claimed

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“allowing access to the multimedia material based on the scheduled broadcast time by unlocking at least one of the locks” is clearly met by the Sie reference.

The Applicants further argue on pages 13-14 that:

Further, any unlocking in Sie allows playback of a **program**, rather than providing **multimedia material related to the scheduled material**. That is, if there is no unlocking, than no program is played in Sie. By contrast, regarding the present invention as recited in independent claims 1 and 12, if there is no unlocking then multimedia material related to the scheduled material is not accessible, while the scheduled material itself is accessible.

In response, the Examiner respectfully disagrees with the Applicants because Sie clearly teaches the claimed “providing multimedia material related to the scheduled material” as described in col. 13, lines 53-67 and shown in Fig. 8B for example, where scheduled programs or multimedia material may be accessed by club members. In addition, Sie teaches that screens allow the user to select **additional products or services** (see col. 1, lines 39-49 and col. 3, lines 50-57), and there is scheduled material that is accessible for users according to their account information/subscription status regardless of whether or not additional multimedia material is accessible.

Claim Objections

3. The numbering of claims is not in accordance with 37 CFR 1.126 which requires the original numbering of the claims to be preserved throughout the prosecution. When claims are canceled, the remaining claims must not be renumbered. When new claims are presented, they must be numbered consecutively beginning with the number next following the highest numbered claims previously presented (whether entered or not).

Misnumbered new claims 22 and 23 have been renumbered as 23 and 24 respectively.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1-5, 7-8, 11-16, 23 and 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Matthews, III et al (USPN 6,025,837), in view of Portuesi (USPN 5,987,509), in further view of Sie et al (USPN 7,024,679).

Regarding claims 1 and 12, Matthews discloses a system and method for providing multimedia services to a digital television receiving apparatus. Matthews discloses a set-top box for receiving digital signals wherein the set-top box or interface means can be located within the television (see col. 5, lines 50-65) and thus discloses the claimed "digital television". Matthews further discloses providing an EPG to the receiving apparatus (see Fig. 2 and Fig. 5). It should be noted that the EPG provides "advance information related to the scheduled broadcast time of scheduled material to be broadcast". Matthews further discloses providing a user with supplemental content to the EPG information and programs to be broadcast (see col. 7, lines 9-31, Fig. 2) by utilizing the URL to search the Internet for the appropriate supplemental content site for delivery to the user (see col. 7, line 64 - col. 8, line 35). Matthews further discloses that the supplemental content is pre-cached or pre-stored in advance of the program (see col. 7, lines 9-42, col. 10, lines 1-10).

Matthews fails to explicitly disclose the claimed, “allowing access to the multimedia material in response to a signal from a broadcaster of the scheduled material.”

In analogous art, Portuesi teaches, “A system and method are provided for displaying an active uniform resource locator during playback of a media file or media broadcast” (see Abstract). Portuesi further discloses, “According to the present invention, associated URL track 20 provides information about URLs to display and make active during certain periods of time with respect to the images 24 in image track 18...” (see col. 5, lines 31-35).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Matthews, based on the teachings of Portuesi, to include the claimed limitation for the benefit of allowing a broadcaster to control when access to the multimedia content, such as URLs, is allowed, in accordance with information or a signal that is sent from the broadcaster in order to make the multimedia or URL(s) active at the receiving apparatus.

Matthews and Portuesi fail to explicitly disclose the claimed, “causing the multimedia material to be cached with locks; and allowing access to the multimedia material based on the scheduled broadcast time by unlocking at least one of the locks.”

In analogous art, Sie et al teaches an embodiment where some programs and additional products or services are downloaded and stored (or cached) locally on a set top box 600 in program server 132 (see Fig. 6). Sie specifically teaches in col. 3, lines 50-61 that, “the subscriber management system 124 [or the claimed “broadcaster”] contains account information for all users such as customer names, addresses, set top box addresses, credit history, subscription status, and video on demand (VOD) status. This information is used to enable

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programs on the set top box(es) 120 of each user. Interactive screens for selecting services are formulated by the subscriber management system 124. The screens allow the user to select **additional products or services...**” The subscriber management system 124 interacts with the program request database 136 in order to provide program entitlement to users (see col. 4, lines 21-23; 35-38; 41-46; 53-55 and 64-67). Control information is sent and received by both the subscriber management system 124 and the set top boxes 120, where in one example, once a program that requires special authorization is requested, the subscriber management system 124 is queried for entitlement (see col. 5, lines 33-38 and 54-63; col. 6, line 63-col. 7, line 8; col. 7, lines 39-43 and 64-65; col. 8, lines 2-13; col. 13, lines 33-35; and col. 22, lines 46-59). Also, control information may be sent to a unique set top box, which may include user specific information, club specific information and programming information, etc. in order to entitle the club programs stored in the set top box for viewing (see col. 7, line 35 – col. 8, line 13; col. 13, lines 19-52; and col. 22, lines 46-59). In col. 4, lines 41-46, as cited above, Sie specifically teaches that some embodiments can limit the amount of times a user can replay a program during a defined period or number of uses in a period, and this usage information is stored in the program request database 135 and used by the subscriber management system 124 before entitling a set top box 120... Furthermore, by sending and/or updating the control information, the set top box in conjunction with the subscriber management system may control what programs the viewer may watch and/or how many times the viewer may watch an enabled or unlocked program. This is equivalent to the claimed causing the multimedia material to be cached with locks, and allowing access to the multimedia material...by unlocking at least one of the locks. Therefore, it would have been obvious to one of ordinary skill in the art to have used

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the teachings of Sie to have limited the time a user can access the multimedia material, or additional products or services, based on the scheduled broadcast time by unlocking or enabling the multimedia material, for the advantage of only allowing access to multimedia material during the scheduled broadcast time in situations where the multimedia material is time dependent on the scheduled broadcast time, such as advertising information or time sensitive news information, for example.

Accordingly, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the combination of Matthews and Portuesi, based on the teachings of Sie et al, to include the claimed limitations described above for the benefit of providing access control of programming or multimedia material that is cached on a receiver based on certain criteria set by a broadcaster.

Regarding claims 2-3, Matthews discloses providing a user with supplemental content for programming in an EPG. Referring to Figure 7, Matthews discloses an EPG screen wherein a user can scroll to view supplemental content including supplemental content for programming which is currently on (i.e. programming which is on at 8 PM).

Regarding claim 4, Matthews discloses the scheduled television program and advance information is provided to the receiving apparatus by an electronic program guide facility (Fig. 2 and Fig. 5).

Regarding claim 5, Matthews discloses in which the material to be broadcast is a television program (see col. 7, lines 9-21).

Regarding claim 7, Matthews discloses receiving the multi-media information via the Internet and the claimed URL (see Fig. 2).

Regarding claim 8, Matthews discloses viewing supplemental content with the EPG but Matthews fails to disclose the claimed providing an indication during broadcast of the material to be broadcast that additional multimedia is available, wherein the URL is inserted into the broadcast stream to determine when the indication is to be provided to the viewer.

As previously described above, Portuesi discloses, "A system and method are provided for displaying an active uniform resource locator during playback of a media file or media broadcast" (see Abstract). Portuesi further discloses, "According to the present invention, associated URL track 20 provides information about URL's to display and make active during certain periods of time with respect to the images...." (see col. 5, lines 31-35). Portuesi further depicts the URL is displayed during a broadcast (see Fig. 3). Portuesi teaches, "In accordance with the present invention, a system and method for displaying uniform network resource locators embedded in a time-based medium are provided that substantially eliminate or reduce disadvantages and problems associated with previously developed time-based and playback operations" (see col. 2, lines 26-31).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to further modify Matthews, based on the teachings of Portuesi, to include the claimed limitations for the benefit enabling a user to directly select a URL by simultaneously displaying the URL with a broadcast and to eliminate and reduce the disadvantages associated with previous systems.

Regarding claim 11, Matthews discloses the claimed set-top box facility (see col. 5, lines 51-65).

Claim 13 is met by the discussions above.

Regarding claim 14, Matthews discloses storing an EPG and thus discloses storing information relating to forthcoming programs and discloses initiating the receiving apparatus to search the Internet to retrieve supplemental content based on a URL (see Fig. 2, col. 8, lines 5-20).

Regarding claim 15, Matthews discloses the claimed, “wherein the digital television apparatus is in the form of a set-top box and further includes an output for providing an output signal to an output display means” (see col. 5, lines 42-65).

Regarding claim 16, wherein the information resource is Internet based (see supplemental content 58 in Fig. 2).

As to claims 23 and 24, the claimed wherein the allowing act allows the access to the multimedia material in response to a signal from a broadcaster of the scheduled material that unlocks the at least one of the locks based on the scheduled broadcast time is met by the Sie et al reference as described above in the rejection of claims 1 and 12.

6. Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Matthews, III et al (USPN 6,025,837), in view of Portuesi (USPN 5,987,509), in further view of Sie et al (USPN 7,024,679), as applied to the claims above, and further in view of Rothmuller (USPN 5,635,989).

Regarding claim 6, Matthews discloses providing supplemental content based on a viewer’s viewing tendencies but fails to disclose providing advance information relates to a pre-determined number of the viewer’s favorite programs.

In analogous art, Rothmuller teaches a method and system for sorting and searching a television program guide to provide a user with a listing of favorite programming. Rothmuller

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teaches, "...the present invention also relates to a method for automatically generating a favorite program list. The favorite program list identifies by title, the programs most frequently watched by the viewer. The favorite program list can also include information, such as, the time and channel of the next occurrence of each program contained in the favorite program list" (see col. 5, lines 52-58). Rothmuller further teaches, "The method allows the viewer to be notified in advance, via on screen message, that a program on the favorite program list will be broadcast in the near future" (see col. 7, lines 40-42). Rothmuller still further teaches the favorite list can be generated by the viewer designating the titles of the programs to be included on the favorite program list (see col. 6, lines 60-67) or the user determines a pre-determined number of the viewer's programs (that which a user adds to the list).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the combination of Matthews, Portuesi and Sie to include the claimed limitation for the benefit of providing a user with advance listing or notice of favorite programs to be broadcast.

7. Claim 9 is rejected under 35 U.S.C. 103(a) as being unpatentable over Matthews, III et al (USPN 6,025,837), in view of Portuesi (USPN 5,987,509), in further view of Sie et al (USPN 7,024,679), as applied to the claims above, and further in view of Enomoto et al (USPN 6,367,080).

Regarding claim 9, Matthews discloses viewing supplemental content with the EPG but Matthews fails to disclose the claimed multi-media material is viewable simultaneously with the broadcast program by means of a split screen or screen insert.

In analogous art, Enomoto teaches an information displaying apparatus which enables the display of television content and Internet content simultaneously (see Abstract, Fig. 16B). Enomoto teaches, "Therefore, recently more and more users are using the Internet as the site of information presentation" (see col. 1, lines 21-23). Enomoto further teaches, "Accordingly, the user of the Internet television as an Internet television displaying apparatus may have occasions desiring to watch a scene as a television broadcast program and the screen of the Internet communication at the same time. Therefore, there has been desired the realization of the Internet information displaying apparatus which can display simultaneously the television broadcast program and the screen of the Internet communication connection..." (see col. 2, lines 10-17). Enomoto is evidence a desire exists to provide a simultaneous display of television content and Internet content in a split screen fashion. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the combination of Matthews, Portuesi and Sie, based on the teaching of Enomoto to include the claimed split screen for the benefit of satisfying a user's desire to see television content and Internet content simultaneously.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael W. Hoyer whose telephone number is **571-272-7346**. The examiner can normally be reached on Monday to Friday from 8:30 AM to 5 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Miller, can be reached at **571-272-7353**.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to customer service whose telephone number is **571-272-2600**.

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system, see **<http://pair-direct.uspto.gov>**. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at **866-217-9197** (toll-free).

May 25, 2007

A handwritten signature in black ink, appearing to read "Michael W. Hoyer". The signature is fluid and cursive, with the first name "Michael" and last name "Hoyer" being the most prominent parts.

Michael W. Hoyer
Patent Examiner
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